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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052897
Party	Defendant Galderma Laboratories, Inc.
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Date	03/16/2015
Attachments	RESTORADERM - Motion to Resume.pdf(283685 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Thomas Sköld

Petitioner.

ν.

Galderma Laboratories, Inc.

Registrant.

Cancellation No.: 92052897

Mark:

RESTORADERM

Reg. Nos.: 2,985,751 and 3,394,514

REGISTRANT'S MOTION TO RESUME PROCEEDINGS

Registrant, Galderma Laboratories, Inc., hereby moves the Trademark Trial and Appeal Board to resume the above-captioned Cancellation, which it suspended sua sponte on January 28, 2015.

I. **Procedural History**

The present Cancellation was filed well over 4 years ago, on August 16, 2010. The long duration has been caused not by inaction by the parties or numerous joint requests for suspension, but instead is the result of robust litigation: numerous depositions, extensive written discovery and document production, and multiple motions for summary judgment. Trial testimony was concluded over 6 months ago, and trial briefing was finished last August. At this point, the only actions remaining in this proceeding are for the Board to hold the Petitioner-requested oral hearing and issue its Decision, something that both parties have wanted.

On September 15, 2014, a week after Petitioner filed its Request for an Oral Hearing, he filed a Complaint against Registrant (as well as Galderma Laboratories, LLC and Galderma S.A.) in the U.S. District Court for the Eastern District of Pennsylvania, and on the following day, filed a "Notice to the Board" simply putting the Board on notice of the civil action. Petitioner's Notice was not a motion for suspension, nor did it include a request for one. On January 28, 2015, however, the Board, apparently believing that Petitioner's Notice had been a motion, "granted" it and suspended these proceedings pending the final determination of the civil action.

While the Cancellation is ready for a final ruling, the civil action is just beginning, without Answers even having yet been filed.

II. Argument

The Board should resume this Cancellation as it has been fully litigated and is ready for decision, whereas the civil action is in its infancy with Answers still to be filed, and since the Board's power to suspend an action pending the outcome of a civil action is discretionary. 37 C.F.R. § 2.117(a). See also TBMP § 510.02(a) ("Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board[.]"). The Board has recognized that the discretionary nature of its power to suspend means that "suspension is not the necessary result in all cases." Boyds Collection Ltd. v. Herrington and Co., 65 U.S.P.Q.2d 2017, 2018 (TTAB 2003). The Board has refused to suspend actions, even when moved to do so by one of the parties, where testimony and briefing periods had concluded and the Board proceeding was ready for a decision. See, e.g., Id. at 2020-21; E.I. du Pont de Nemours and Co. v. G.C. Murphy Co., 199 U.S.P.Q. 807, 808 n.3 (TTAB 1978); Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 U.S.P.Q. 429, 430 (TTAB 1973).

Suspension pending the outcome of Petitioner's civil action is neither necessary nor in the service of judicial economy. The Board has developed a policy of continuing an action notwithstanding a request for suspension when it has been asked to issue a potentially dispositive ruling before a Request for Suspension is received. See TBMP § 510.02(a). The purpose of this policy is to "prevent a party . . . from escaping [a potentially dispositive] motion by filing a civil action and then moving to suspend before the Board has decided the . . . motion." This policy is served whether a potentially dispositive motion is pending or, as is the case here, the proceeding is ready for final decision. See TBMP § 510.02(a); see also Boyds v. Herrington, 65 U.S.P.Q.2d at 2018 (TTAB 2003).

Here, the parties have spent more than four years aggressively litigating this matter before the Board, engaging in motion practice, conducting extensive discovery, taking testimonial depositions, and fully briefing the case. All testimony and trial periods have closed, and neither party requested that these proceedings be suspended. All that remains to this action are an oral hearing and the Board's final decision. Continuing the suspension in the instant action will only "delay the outcome of this proceeding when there would be little or nothing to resume upon conclusion of [P]etitioner's civil suit." *Id.* at 2019.

The Board should not allow such delay here, where trial has already concluded and the civil action is just beginning. These circumstances warrant an exercise of the Board's discretion to remove the suspension and continue the proceedings.

For the foregoing reasons, Registrant moves the Board to reverse its suspension order and resume these proceedings.

Respectfully submitted,

Jeffrey M. Becker, Esq. Richard D. Rochford, Esq. Attorneys for Registrant

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 16th day of March 2015, the foregoing Registrant's Motion to Resume Proceedings was served on Petitioner's counsel of record, via email to the following:

Arthur E. Jackson Moser IP Law Group artjcksn@gmail.com docketing@mtiplaw.com